

JUN 22 2007

Docket No. F-8340

Ser. No. 10/502,264

REMARKS

Claims 15 and 16 remain pending in this application. Claims 1-16 are rejected. Claims 1-14 and 17-31 are cancelled herein. Claims 15 and 16 are amended herein to merely stand in independent form without change of substance.

OBJECTIONS TO CLAIMS

Claim 4 is objected to for reciting a "predetermined manipulation suppression program." Claim 4 is cancelled rendering said objection moot. The wording of claim 4 is now incorporated into claims 15 and 16 because the claims are amended to stand in independent form and includes allowable subject matter as indicated in the Office Action. The wording of former claim 4 for is now amended to remove the word "predetermined" as it is viewed that the word did not serve to patentably distinguish the invention and its elimination places the claims into allowable form and broadens the claims. Withdrawal of the objection is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-10 are rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of informalities stated in the Office Action. Applicant respectfully traverses the Examiner's rejection as it may apply to amended claim 15 incorporating the wording of rejected claim 4.

Docket No. F-8340

Ser. No. 10/502,264

The Examiner states that "the preamble 'A recording medium having ... as a video game machine comprising' " is ambiguous. Applicant respectfully strongly disagrees with the Examiner's position since it seems to ignore all the wording used in the portion of the preamble omitted in quotation as designated by the ellipse of the above quoted passage.

The preamble of the present claim is most precise and definite in the subject matter to which it applies. The Examiner cannot take beginning wording and ending wording of the preamble out of context because it is an axiom that claims are interpreted as a whole.

The preamble of the claims specifically recites the claim is directed to a "recording medium." This is the subject matter of the claims. The remaining wording is clear on its face as a characterization of the recording medium. Contrary to the Examiner's out of context assertion that the claims states "A recording medium comprising a detecting means ..., and an executing means ..." the claim in fact states that the recording medium has stored "stored thereon in executable form a game program and a manipulation suppression program." The preamble goes on to characterize the *program which is stored* as being "configured so as to control a programmable device to function as a video game machine comprising.." The remaining body of the claim recites the functions that the program effects upon the video game machine in terms of the operating portions of the video game machine. The program, as required by the preamble is presented on the recording medium in

Docket No. F-8340

Ser. No. 10/502,264

executable form making it clearly statutory subject matter because the recording medium functions to configure a programmable device.

Thus, it is clear from the above that the claims is directed to a recording medium with an executable program stored thereon. There is absolutely nothing ambiguous about the claim and it is requested that the Examiner consider the *entire* wording of the preamble rather than taking beginning and ending snippets out of context. There is no precedent in case law nor MPEP guidelines prohibiting claiming an executable program in terms of the functioning of the programmable device which it is used to configure. Thus, the configuration of the recording medium is properly claimed in terms of the functions achieved by its configuring a programmable device.

The Examiner queries "How could a storage medium comprise physical elements such as a detecting means or executing means?" It should be readily evident from the above explanation that Examiner's question is directed to something that does not exist in the claims. It is not claimed that "a storage medium comprise physical elements such as a detecting means or executing means." Rather, what the text of the claim clearly conveys is that the executable program is such that it configures a programmable device to act as such means. "[T]he definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." *Application of Moore*, 169 USPQ 236, 239 (CCPA 1971). It is respectfully

Docket No. F-8340

Ser. No. 10/502,264

submitted that one skilled in computer programming and engineering programmable devices would readily appreciate that the claim is directed to a recording medium having an executable program which configures a device to act as units functioning as claimed.

It is respectfully requested that the Examiner consider the entire text of the claim as is required in patent examination. Reconsideration of the rejection in terms of its application to claim 15 an allowance of claim 15 and 16 are earnestly requested.

**CLAIM REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH,
DESCRIPTION REQUIREMENT**

Claims 1-14 are rejected under 35 U.S.C. § 112, first paragraph, for containing subject matter lacking an adequate written description in the specification. Since claims 1-14 are now cancelled, applicant herein respectfully traverses this rejection as it might be applied to claim 15.

The description requirement of the first paragraph of 35 U.S.C. § 112 functions to ensure that the inventor had possession of the subject matter later claimed. How the specification satisfies this requirement is immaterial. It is not necessary that the application describe every claim exactly, but only so much that

Docket No. F-8340

Ser. No. 10/502,264

persons of ordinary skill in the art will recognize from the disclosure that the applicant invented the subject matter with the claimed limitations. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90, 96 (CCPA 1976). In other words, the claimed subject matter need not be described in *haec verba* in the specification in order for the specification to satisfy the description requirement. *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). Therefore, a determination of fulfillment of the description requirement under § 112, first paragraph, turns on whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986).

The Examiner contends that the description does not disclose "the predetermined manipulation unnecessary (sic) adversely affects a life span of the input device." In this regard the Examiner's attention is respectfully directed to the specification at page 17 wherein the following is explicitly stated:

Herein, the inhibited act is applicable to an act which may adversely affect the endurance or the like of a video game machine, particularly a cellular phone. Such an act includes a user's act of continually and repeatedly pushing down a specific button of a manipulation member a predetermined number of times, the act of pressing a specific button of the manipulation member at or over a predetermined pressure, the act of applying force from outside such as dropping the manipulation member, and another such act.

Docket No. F-8340

Ser. No. 10/502,264

The above recitation is put forth merely as showing and example of acts that the invention is applicable to and is not intended to be interpreted as limiting interpretation of the claims. "Endurance" clearly equates to a functional life of an article.

Therefore, in view of the above, consideration of the rejection of claims as may be applied to claims 15 and 16 is respectfully requested. Should such rejections be subsequently made, it is requested that the Examiner explain the grounds for the objection and rejections, addressing the above remarks, to comply with satisfying the burden of the PTO in asserting the rejection. "The burden of showing that the claimed invention is *not* described in the application rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient." *In re Edwards, Rice, and Soulen*, 196 U.S.P.Q. 465, 469 (CCPA 1978) citing: *In re Salem*, 553 F.2d 676, 682, 193 USPQ 513, 518 (CCPA 1977); *In re Wertheim*, 541 F.2d at 265, 191 USPQ at 98.

NO FEE DUE

No fee is believed due. If there is any fee due the USPTO is hereby authorized to charge such fee to Deposit Account No. 10-1250.

JUN 22 2007

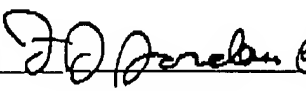
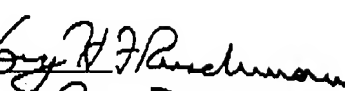
Docket No. F-8340

Scr. No. 10/502,264

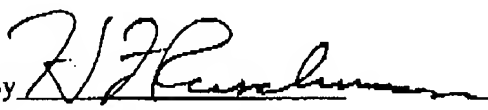
In light of the foregoing, the application is now believed to be in proper form
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,

JORDAN AND HAMBURG LLP

By  
Frank J. Jordan *Reg 35,341*
Reg. No. 20,456
Attorney for Applicants

and,

By 
Herbert F. Ruschmann
Reg. No. 35,341
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340